

REMARKS

The claims presently being prosecuted in this patent application are claims 1-20, 23 and 24. The Applicant's attorney hereby affirms his election to prosecute these claims that were designated by the Examiner as Invention II.

The Applicant's attorney notes that the Examiner has indicated that the IDS is in compliance with 37 CFR § 1.97 and therefore the references submitted therewith have been considered by the Examiner.

The Examiner has indicated that the title of the invention is not descriptive and has suggested a new title. The Applicant's attorney has amended the title to utilize the title suggested by the Examiner. While the original title is believed to be sufficiently descriptive for the patent application, as filed, the Applicant's attorney agrees that the Examiner's suggested title is more descriptive of the invention as defined in the claims that are now being prosecuted as a result of the election made above.

The Examiner has objected to the abstract of the disclosure for reciting the phrase "The present invention provides...". The Applicant's attorney has now cancelled this phrase. It is believed that the remainder of the abstract of the disclosure, after canceling the above phrase, is in compliance with MPEP § 608.01(b) as set out by the Examiner in the Office Action.

The Examiner has rejected claims 9, 10, 12, 19, 20 and 24 under 35 USC § 112, second paragraph, as being indefinite for

failing to particularly point out and distinctly claim the subject matter which Applicant regards as his invention.

First, the Examiner rejects claims 9 and 10 for reciting "...weight percent, polymer". The Applicant has taken the Examiner's suggestion and inserted "of said" prior to the --polymer-- to make it clear that the polymer refers back to "film-forming, carboxylic acid-containing polymer" recited in step (a) of claim 1.

Second, the Examiner has rejected claims 9, 10, 19 and 20 for weight percentages that are unclear. It is believed that, as written, the weight percentages refer to the weight of the "solution or emulsion" of step (a) in claim 1. This is so because of the use of "said" in defining the solution or emulsion. However, to make this reference back clearer, the Applicant's attorney has inserted "aqueous" prior to --solution or emulsion-- to make the reference back even more clear.

Third and finally, the Examiner has rejected claims 12, 19, 20 and 24 for providing an insufficient antecedent basis for the term "said polymer". The Applicant's attorney has amended these claims to replace "polymer" with --copolymer--. The term "copolymer" has antecedent support step (a) of claim 11 in view of the term "a carboxylic acid-containing copolymer".

The Examiner has rejected claims 1-4, 6, 7, 9-14, 16, 17, 19 and 20 under 35 USC § 102(b) as being anticipated by Roberts (U.S. Patent 5,453,459).

In particular, the Examiner cites column 13, lines 39-56 of Roberts which describes a method of protecting structures

against graffiti. The Applicant's attorney has amended the pending claims to more particularly point out the invention as method of masking a portion of a surface which is to be coated to temporarily protect a portion of that surface from such coating. Thus, claims 1 and 11 now clearly point out a portion of a surface which is to be coated is protected from unwanted coating by applying an aqueous solution or emulsion of a film-forming carboxylic acid-containing polymer, as a masking material, and the remainder of the surface is coated with a coating compound.

In Roberts, the entire surface which is to be protected from graffiti is coated and no surface is deliberately left unprotected to be coated with graffiti. Thus, Roberts, in effect, now teaches away from the invention as described in the claims as presently amended.

The Examiner has also rejected claims 5 and 15 under 35 USC § 103(a) as unpatentable for obviousness over Roberts in view of Zajac (WO 98/55535).

The Examiner argues that while Roberts does not teach the use of EDTA in his coatings, Zajac teaches compositions comprising (meth)acrylic acid copolymers to which are added EDTA as a chelating agent. As stated above, since claims 1 and 11, from which claims 5 and 15 are dependent, respectively, are not unpatentable over Roberts, it is believed the combination of Roberts and Zajac do not make claims 5 and 15, unpatentable for obviousness.

The Examiner has also rejected claims 8 and 18 under 35 USC § 103(a) as unpatentable for obviousness over Roberts in view of Maxwell.

The Examiner argues that while Roberts is silent regarding the viscosity of his coatings, Maxwell teaches "the viscosity can be adjusted by varying the relative amounts of the resin components". However, Maxwell does not teach the specific viscosity range that applicant prefers as defined in claims 8 and 18. Moreover, as stated above, since claims 1 and 11, from which claims 8 and 18 are dependent, respectively, are not unpatentable over Roberts, it is believed the combination of Roberts and Maxwell do not make claims 8 and 18, unpatentable for obviousness.

The Examiner has also rejected claims 23 and 24 under 35 USC § 103(a) as unpatentable for obviousness over Roberts in view of Zajac and Kawabata.

The Examiner argues that while Roberts does not teach the use of a copolymer of methacrylic acid and ethyl acrylate in his coatings, Zajac and Kawabata teaches compositions comprising (meth)acrylic acid and ethyl acrylate copolymers. As stated above, since claims 1 and 11, from which claims 23 and 24 are dependent, respectively, are not unpatentable over Roberts, it is believed the combination of Roberts and Zajac and Kawabata do not make claims 23 and 24, unpatentable for obviousness.

The Examiner's attention is directed to newly added claims 27 and 28 which claim a preferred embodiment of the present invention. At page 13, lines 4-8 of the specification, it is pointed out that the masking material utilized in the method of

the present invention may be removed by water. This is obviously desirable from a pollution standpoint and is not disclosed in Roberts.

In view of the above, it is believed that the claims, as now amended, are patentable over the prior art. The Examiner is asked to reconsider and withdraw his rejections and pass such amended claims to issue.

Respectfully submitted,



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May 30, 2003
5/30/03

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